



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,550	11/28/2003	Adam Ewles	101964.0001US1	8360
24392 7590 01/31/2011 FISH & ASSOCIATES, PC ROBERT D. FISH 2603 Main Street Suite 1000 Irvine, CA 92614-6232				
EXAMINER GORDON, STEPHEN T				
ART UNIT		PAPER NUMBER		
3612				
NOTIFICATION DATE		DELIVERY MODE		
01/31/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rfish@fishiplaw.com
patents@fishiplaw.com

Office Action Summary

Application No.

10/722,550

Applicant(s)

EWLES, ADAM

Examiner

/Stephen Gordon/

Art Unit

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-840)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election without traverse of species B in the reply filed on 12/3/10 is acknowledged. No claims are presently withdrawn from consideration.

2. The disclosure is objected to under 35USC – section 112, first paragraph because of the following:

The description of the tensioning apparatus beginning at page 11 - line 18 through page 12 - line 6 is confusing, and the exact configuration of such assembly is not wholly understood. This issue is exacerbated by the lack of any rendering of such assembly in the originally filed drawing figures. As a final note, the majority of the drawing reference numbers used throughout this section are not included in the drawing figures.

Appropriate correction is required.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In general claims 9 and 10 are particularly confusing as it is not entirely clear how the recited device would be configured – note no drawing figures showing any of the detail of the recited tensioning apparatus is provided in the originally filed specification. For example, it is not entirely clear how the attachment devices or tensioning device would be configured. Would the bore hole attachment device extend all of the way through the holes? Would it be U-shaped and extend only partially through each hole? If so, how would the clamp halves be locked? Would some type of cotter pin assembly be employed? etc.

5. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 – last two lines, “said elongated, rigid member” lacks clear antecedent basis and should apparently be –said elongated substantially rigid member—for consistency/clarity.

Claim 4, the recited interior surface in line 1 is confusing and apparently constitutes a double inclusion of the interior surface of the base claim.

Claim 5 – line 1, “said recessed interior surface” lacks clear antecedent basis as multiple such surfaces are previously recited.

Claim 6, the recited “at least one interconnecting element” of line 2 and lines 3-4 (i.e. 2 places total) are somewhat confusing as it is not entirely clear if/how such elements relate back to the elements of the beginning of line 2.

Claim 7, "said interconnecting elements" is generally very confusing in view of the multiple recitations of interconnecting elements in intervening claim 6. Does "said interconnecting elements" reference the elements on line 2 of claim 6, line 4 of claim 6, or all of the previously recited such elements? Etc.

Claims 9 and 10, the claims are generally confusing, and the exact configuration of the defined invention is not understood for the reasons discussed above regarding the section 112 – first paragraph rejection.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4-6, and 9-10 rejected under 35 U.S.C. 102(b) as being anticipated by Howells '564.

Howells teaches a tie-down apparatus releasably attachable to a vehicle having an elongated rigid member including first and second hinged clamp halves 15,16, a hinge 17+, and bore holes (at 18,19 for receiving element 20+).

Claim 1, the device is configured and operates as broadly claimed. The device defines an interior recessed surface corresponding in shape as broadly claimed and as best understood.

Claims 4-6, the device is configured as broadly claimed and as best understood.

Claims 8-9, the device is configured as broadly claimed and as best understood. Note chain element 33+ reads on the defined tie-down apparatus as best understood.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-3, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Howells '564 in view of Burgoon et al. '034

Regarding claims 2 and 3, Howells teaches all of the defined features as discussed above regarding claim 1 but fails to specifically teach use of a lining as defined.

Burgoon et al teaches a vehicle element securing clamp relying on two pivoted clamp halves and utilizing a scratch resistant interior surface lining 21 constructed of rubber, PVC tube etc.

In order to better protect a handled object from damage, it would have been obvious to one of ordinary skill in the art to line the interior surface of the clamp halves of Howells with a scratch resistant material (e.g. rubber etc.) in view of the teachings of Burgoon et al.

10. The failure to apply the prior art to claims 7-8 should not be construed as an indication of allowable subject matter. Because these claims so seriously fail to meet

the requirements of 35USC112 – second paragraph for the reasons stated above, it is not possible at this time to apply the prior art to the claims in deciding patentability without disregarding portions of the express wording of the claims and thus resorting to speculation and conjecture as to the particular invention defined therein. See Ex parte Lyell, 17 USPQ2d 1548, 1552.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gordon whose telephone number is (571) 272-6661. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday from 8:00am to 4:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen Gordon/

Application/Control Number: 10/722,550
Art Unit: 3612

Page 7

Primary Examiner
Art Unit 3612

stg